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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/449,976	11/26/1999	SATORU MAEDA	7217/60194	6965

7590

02/26/2003

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EXAMINER

GRANT, CHRISTOPHER C

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application

09/449,976

Applicant(s)

MAEDA ET AL.

Examiner

Christopher Grant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Schein et al. (Schein).

Considering claims 1-3, Schein discloses a television receiver (510, 520) comprising:

- a) a connection interface (518) for connection to an external mail server (Internet, col. 19, lines 31-36);
- b) electronic mail means (col. 19, lines 31-50);
- c) display means (510);
- d) summary extraction means (summary list of addresses, dates and subjects for each message illustrated in figure 15B);
- e) superimposing means (figures 15B and 15C illustrate the currently tuned program at a reduced size, see figure 12A, item 726 and col. 18, lines 12-14, simultaneously with the summary e-mail list); and
- f) control means (an inherent circuit necessary for properly combining the currently tuned program and the summary e-mail list with timing signals, clocks and/or vertical/horizontal synchronizing signals). Also see controllers (404, 424 and 434 of figure 7, col. 10, line 24 – col.

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8, line 38) that are necessary for combining television programs with additional data obtained from an external server.

Claim 4 is met by the scrolling action discussed at page 19, lines 39-41.

3. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Yen et al. (Yen).

Considering claims 1-3, Yen discloses a television receiver (figure 1) comprising:

- a) a connection interface (112) for connection to an external mail server (col. 5, lines 15-20);
- b) electronic mail means (see the entire reference including but not limited to col. 5, lines 28-54);
- c) display means (131);
- d) summary extraction means (“selectable identifier” or “indicator of content” being the “subject matter” and/or “email address”, col. 6, lines 30, col. 7, lines 10-25, 40-48, col. 11, lines 50-51, col. 13, lines 44-48 and 50-60);
- e) superimposing means (120) for superimposing the e-mail summary (indicator) from internet access (112) as the foreground element (122) along with the television program as the background element (121) from tuner (111), col. 9, lines 13-35; and
- f) control means (col. 4, lines 47-51, col. 5, lines 55-63, col. 6, lines 1-6, and all the control operations relating to “tags”, “alerts”, “priorities” discussed throughout the reference including but not limited to columns 11-12).

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Claim 4 is met by linear direction (horizontal sweep) or from top to bottom (vertical sweep) as discussed in col. 13, line 60 – col. 14, line 15.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schein in view of Applicant's admitted prior art at page 1 of the specification.

Considering claim 5, Schein discloses accepting a command for displaying a detail or body of the e-mail as illustrated in figure 15C and described at col. 19, lines 31-50. However, he fails to specifically disclose displaying the e-mail on an entire screen of the display as recited in the claim.

Applicant conceded on page 1, of the specification, that it is known in the art to provide an electronic mail on a full screen of the television display. This procedure enables the user to appropriately read the detail information or body of the e-mail.

It would have been obvious to one of ordinary skill in the art to modify Schein's system (if necessary) to include displaying the e-mail on an entire screen of the display for the typical advantage of enabling the user to appropriately read the detail information or body of an e-mail.

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6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yen in view of Applicant's admitted prior art at page 1 of the specification.

Considering claim 5, Yen discloses accepting a command for displaying a detail or body of the e-mail as described at col. 11, line 15 – col. 12, line 54. However, he fails to specifically disclose displaying the e-mail on an entire screen of the display as recited in the claim.

Applicant conceded on page 1, of the specification, that it is known in the art to provide an electronic mail on a full screen of the television display. This procedure enables the user to appropriately read the detail information or body of the e-mail.

It would have been obvious to one of ordinary skill in the art to modify Yen's system (if necessary) to include displaying the e-mail on an entire screen of the display for the typical advantage of enabling the user to appropriately read the detail information or body of an e-mail.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Foladare et al. disclose sending summary e-mail to a set-top box.

Segman discloses sending a sender of an e-mail in a sub-window of the television screen.

8. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an

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individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

on _____.
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) ____ - ____ on _____.
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

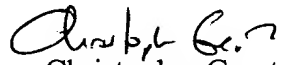
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Grant whose telephone number is (703) 305 4755.

The examiner can normally be reached on Monday-Friday 8:00am - 5:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872 9314 for regular communications and (703) 872 9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.


Christopher Grant
Primary Examiner
Art Unit 2611

CG
February 22, 2003